

### **Remarks**

This Amendment is responsive to the Office Action mailed August 23, 2004 which allowed claims 1-19 and 21-29, rejected claim 30, and objected to claims 31-33. In response, the Applicant has herein amended claims 30-32. The amendments more particularly point out and distinctly claim that which is patentable subject matter. These amendments are proper, do not introduce new matter, do not require additional searching, are not narrowing in view of a prior art rejection, and place the application in proper condition for allowance of all pending claims.

### **Rejection Under Section 102**

#### **Claim 30**

Claim 30 was rejected as being anticipated by Butts '153. This rejection is respectfully traversed because Butts '153 does not disclose the recited feature "*steps for inserting....*"

Claim 30 is written in accordance with 35 U.S.C. §112, sixth paragraph. The Applicant has identified the function associated with the recited "steps for clause" as being the controlled insertion of a first member onto a second member so as to qualify the disc drive in terms of an observed resistance to the insertion in relation to a displacement of the first member with respect to the second member. The disclosed structure performing this function includes the head stack assembly installation system 200, including the components thereof individually and cooperatively. For example, the disclosed structure includes but is not limited to the displacement potentiometer 248, the LVDT 250, and the load cell 252.

Contrarily, Butts '153 taken as a whole, and particularly that portion on which the Examiner relies, does not contemplate the identical function as the claimed invention; namely, Butts '153 is wholly silent regarding any contemplation of a controlled attachment

of the head stack assembly into the head disc assembly.

The Examiner is obliged as a matter of law to construe this steps for clause in view of the disclosed structure and equivalents thereof. See *B. Braun Medical, Inc. v. Abbott Lab.*, 43 USPQ2d 1896, 1900 (Fed. Cir. 1997); *In re Donaldson Co. Inc.*, 26 USPQ2d 1845 (Fed. Cir. 1994)(*en banc*); *In re Dossel*, 42 USPQ2d 1881 (Fed. Cir. 1997); *Supplemental Examination Guidelines for Determining the Applicability of 35 U.S.C. 112, Para. 6*, 65 FR 38510.

Failure to do so constitutes reversible error.

When this steps for element is properly construed, it is clear that the cited references, taken as a whole, fail to disclose this element. Butts '153 does not contemplate any structure capable of providing a controlled insertion of the head stack assembly into the head disc assembly, or for qualifying the disc drive based on an observed resistance force to the insertion thereof. Accordingly, the rejection of claim 30 under Section 102 is erroneous as a matter of law. Nevertheless, the Applicant has amended claim 30 solely to more particularly point out and distinctly claim the patentable subject matter thereof. Reconsideration and withdrawal of the rejection of claim 30 and the claims depending therefrom are respectfully requested.

### **Objection to Claims**

The Applicant gratefully acknowledges the indication of allowable subject matter. Claims 31-33 were objected to as being dependent upon a rejected independent claim, but allowable if amended to place in independent form. The Applicant believes that the independent claim 30 is allowable, for reasons above, and has elected not to place the dependent claims 31-33 in independent form.

### **Conclusion**

This is a complete response to the Office Action mailed August 23, 2004. The Applicant respectfully requests that the Examiner enter the above amendments, reconsider the application and allow all of the pending claims. The Examiner is invited to contact the below signed Attorney should any questions arise concerning this response.

Respectfully submitted,

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### **Amendments to the Drawings**

In FIG. 10, the “HSA PRESENT DIGITAL SENSOR” of item 204 has been changed from item 238 to item 228.

Attachment: Replacement Sheet 6/10  
Annotated Sheet 6/10 Showing Changes



6/10

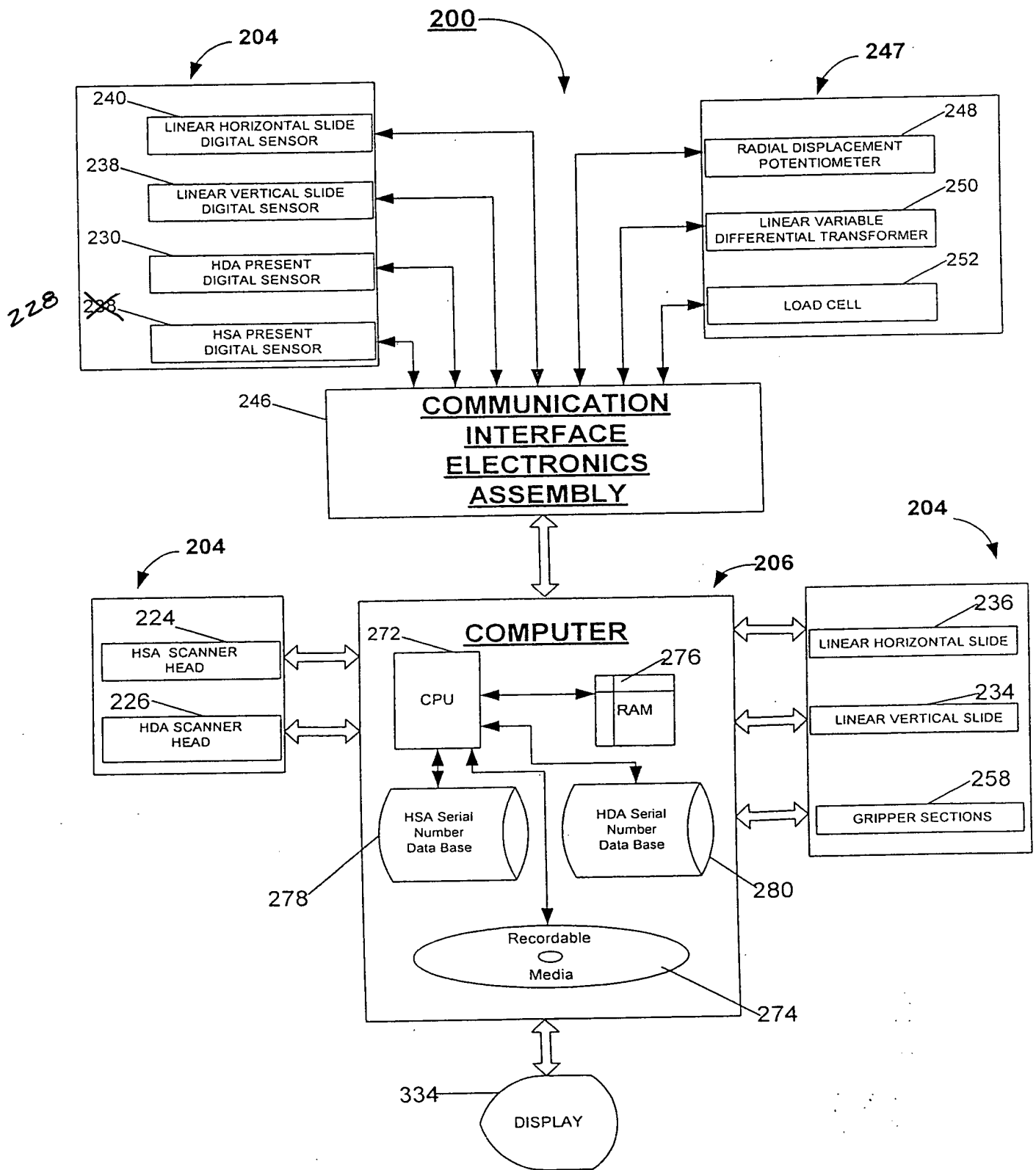


FIG. 10